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OFFICE OF PETITIONS

In re Application of Lees et al. :
Application No. 10/692,908 :
Filing Date: October 24, 2003 :
Attorney Docket No. 033849-000007 :

Decision on Petition

This is a decision on the petition under 37 CFR 1.137(a), or in the alternative under 37 CFR 1.137(b), filed November 7, 2005, to revive the above-identified application.

The petition under 37 CFR 1.137(a) is **dismissed**.

The petition under 37 CFR 1.137(b) is **granted**.

Facts:

A Notice of Allowance was mailed for the instant application on February 11, 2005. The Notice required payment of \$1,400 for the Issue Fee and \$300 for the Publication Fee.

Petitioner contends the Office incorrectly charged \$1,285 for PCT/US05/14937 on May 6, 2005.

As of May 9, 2005, assuming the funds above were charged in error, the balance in petitioner's deposit account should have been \$1,870.

On May 10, 2005, petitioner filed application no. 11/125,688 along with a transmittal form authorizing the Office to charge \$1,200 to petitioner's deposit account.

On May 11, 2005, petitioner filed an issue fee transmittal form for the instant application. The form authorized the Office to charge a total of \$1,730 to petitioner's deposit account for the issue fee, publication fee, and 10 copies of the patent.

The Office does not always attempt to charge a fee for an application on the same date the Office receives a deposit account authorization. Therefore, a petitioner must ensure that the deposit account contains sufficient funds until the time the fee is charged.

On May 12, 2005, \$300 was charged for application no. 11/125,688.¹ After the \$300 charge, the account only had a balance of \$285.

¹ The remaining fees were later charged to petitioner's deposit account on June 21, 2005.

From May 12, 2005, until May 20, 2005, the deposit account balance was \$285. Even if the deposit account had not been charged an extra \$1,285 for the PCT application, the balance would have been below \$1,700 (issue fee + publication fee).

The petition under 37 CFR 1.137(a)

The showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 CFR 1.137(a).

“[T]he question of whether an applicant’s delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account.”² The general question asked by the Office is: “Did petitioner act as a reasonable and prudent person in relation to his most important business?”³

Petitioner's deposit account had a balance of \$1,870 after May 6, 2005, if the correct fees had been charged on the date the May 6, 2005 paper was filed.

On May 10, 2005, petitioner submitted authorization to charge \$1,200 to petitioner's deposit account for application no. 11/125,688.

On May 11, 2005, petitioner submitted authorization to charge \$1,730 to petitioner's deposit account for the instant application.

A reasonable and prudent person would have not expected the deposit account to have sufficient funds to cover the fees for application no. 11/125,688 *and* the fees for the instant application.

Petitioner contends a reliable business routine was in place to ensure the deposit account would always contain sufficient fees for all patent related expenses. However, the petition fails to specify how often Kimberly Tobola audits the deposit account. The petition does state the May 6, 2005 error in charging excess fees was caught on June 29, 2005, which is more than 7 weeks later.

Petitioner has failed to specify how often the deposit account is funded to maintain a balance of at least \$5,000.

For all the reasons above, the petition fails to prove the entire delay in the submission of the issue fee was unavoidable.

The petition under 37 CFR 1.137(b)

Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b). Therefore, the petition is granted and the application is revived.

² Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (1982).

³ See In re Mattullath, 38 App. D.C. 497 (D.C. Cir. 1912).

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a request to change the address of record should be filed. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

The Office of Patent Publications will be informed of the instant decision and will take steps to issue the application as a patent.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.



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